

**REMARKS**

The present patent application has been reviewed in light of the office action, dated June 17, 2005, in which, claims 2, 7, 10, 11, 16, 19, and 29-39 stand rejected under 35 USC 101; and claims 2-38 stand rejected under 35 USC 103 on Frazier Jr. (hereinafter "Frazier") or Kaufman et al. (hereinafter "Kaufman") in view of Short et al. (hereinafter "Short"). Reconsideration of this patent application in view of the foregoing amendment and following remarks is respectfully requested.

Claims 2-59 are pending. New claims 40-59 have been added; however, claims 42-59 correspond to claims 2-19 previously allowed in a notice of allowance mailed on March 19, 2004. No claims have been cancelled. Claims 2, 10, 16, 19, 20, 27, 28, 29, 37 and 39 have been amended; however, these amendments do not narrow scope and, therefore, no prosecution history estoppel results. These amendments are intended to leave claim scope unaltered or to broaden claim scope.

The Examiner has rejected claims 2, 7, 10, 11, 16, 19, and 29-39 under 35 USC 101 as being directed to non-statutory subject matter. This rejection by the Examiner of these claims on this basis is respectfully traversed.

It is noted that since the Examiner issued this office action, the USPTO Board of Appeals and Interferences has decided In re Lundgren, Appeal No. 2003-2088, Application 08/093,516, heard April 20, 2004. It is asserted that in light of this case the Examiner has failed to establish a prima facie case of non-statutory subject matter.

In particular, the Examiner has failed to establish that the rejected claims fall into a judicially created exception to statutory subject matter. The Examiner asserts that the rejected claims do not involve, use, apply or advance the technological arts; however, while Assignee does not agree with the Examiner's position, it is pointed out that In re Lundgren rejects the technical arts test applied by the

Examiner. Therefore, regardless of whether the Examiner's assertion is correct, which Assignee disputes, it would not matter since this test is no longer applied by the US PTO.

The Examiner also asserts that what is claimed is merely an abstract idea; however, here Assignee asserts that the Examiner is not correct. The Federal Circuit case, A&T v. Excel, 50 USPQ2d 1447 (Fed. Cir. 1999), provides guidance regarding the difference between statutory subject matter and an abstract idea. It is asserted that here the rejected claims provide a practical application that produces a useful, tangible and concrete result, as explained in that case. If the Examiner disagrees, Assignee requests that the Examiner provide on the record his reasons for believing that a useful, tangible and concrete result is not produced here. Since Assignee believes that such a result is produced, it is respectfully requested that the Examiner withdraw his rejection of these claims on this basis.

The Examiner has also rejected claims 2-38 under 35 USC section 103 on Frazier Jr. (hereinafter "Frazier") or Kaufman et al. (hereinafter "Kaufman") in view of Short et al. (hereinafter "Short"). This rejection of these claims on this basis is respectfully traversed.

As Assignee has previously explained in a prior response, Kaufman, Fraizer and Short describe communication systems that have spreading code sequences that are time invariant. Assignee has attempted to use the term "temporal" to refer to spreading code sequences that are not time invariant. For example, Figure 2 and the associated text of the present application illustrates an embodiment in which the spreading code sequence may be changed, although, of course, claimed subject matter is not limited in scope to this particular embodiment. Nonetheless, it appears from the Office Action that the Examiner has taken issue with this terminology. Thus, to satisfy the Examiner, Assignee has amended the claims to remove the term "temporal" and refer to changing the sequence at various intervals.

It is asserted the no prosecution history estoppel should result from these amendments. The claims as amended are either as broad or broader than the claims prior to amendment.

Claim 2, as amended, and the rejected claims that depend from it, are believed to patentably distinguish from the cited patents. The patents cited by the Examiner do not teach, suggest, or show spreading code sequences that change at various intervals. It is, therefore, respectfully requested that the Examiner withdraw his rejection as to these claims. These claims are believed to be in condition for allowance. It is respectfully requested that these claims be permitted to proceed to issuance.

The remaining rejected claims also patentably distinguish from the cited patents at least for similar reasons. It is, therefore, respectfully requested that the Examiner withdraw his rejection of these claims. These claims are also believed to be in condition for allowance. It is respectfully requested that these claims also be permitted to proceed to issuance.

It is noted that claimed subject matter may be patentably distinguished from the cited patents for additional reasons; however, the foregoing is believed to be sufficient. Likewise, Assignee's failure to respond to a particular position taken by the Examiner in this or prior Office Actions is not an indication of agreement or acquiescence with the Examiner's position. Rather, it is believed to not be necessary to respond to every position taken by the Examiner in this or other correspondence. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

New claims 40 and 41 depend from claim 2 and patentably distinguish from the cited patents on at least the same basis. New claims 42-59 correspond to claims 2-19 that were previously allowed in a

notice of allowance mailed on March 19, 2004. Therefore, these new claims, 40-59, are in condition for allowance as well and Assignee requests that the Examiner permit them to proceed to issuance.

Please charge any underpayments or credit any overpayments to deposit account no. 50-3703

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of the present patent application and early allowance of all the claims, as amended, is respectfully requested.

Respectfully submitted,



Howard A. Skaist  
Reg. No. 36,008

Dated:

12/19/05

Berkeley Law and Technology Group, LLC  
1700 NW 167<sup>th</sup> Place, Suite 240  
Beaverton, OR 97006  
(503) 439-6500